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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,852	11/07/2001	Takashi Enokihara	100809-00085(SCEI 19.066)	7911
26304	7590	07/22/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			PSITOS, ARISTOTELIS M	
			ART UNIT	PAPER NUMBER
			2653	
DATE MAILED: 07/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/044,852

Examiner

Aristotelis M Psitos

Applicant(s)

ENOKIHARA, TAKASHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 and 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's response of 4/7/04 has been considered with the following results.  
Claims 6-9,14-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/7/04 **Priority**

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### Information Disclosure Statement

The IDS of 4/11/02 has not been made of record. Regrettably the 1449 forms have been misplaced. Applicants' representative submitted (faxed) a copy of the IDS of 4/5/04 and the documents listed thereon have been made of record.

### Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 1-3,5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song considered with JP 63-161538 both further considered with JP 64-035731..

Song discloses in this environment the overall disc drive system as depicted in figure 2, controller, tracking actuator, sled motor and spindle motor. See further discussion with respect to figure 2. There are no particulars of these standard subsystems.

As noted in the accompanying search report of 4/5/04, JP 63-161538 discloses slider control predicated upon averaging track error signals. Furthermore, JP 64-035731 provides for the offset control ability.

It would have been obvious to modify the base system of Song with the additional teachings from both of the secondary JP systems, (thereby meeting the remaining elements in the independent claim(s), offset value acquisition means, and computation and comparison means as found in claim 1 for instance) so as to control the disc drive appropriately and correct for drive errors.

With respect to dependent claim 2, the rotation adjustment element is considered met by the primary reference.

With respect to claim 3, the examiner concludes that such addition and averaging have been met by the JP 63-161538 reference.

With respect to claim 5, because the Song system is controlled by a controller, and as known these devices operate in response to a set of programmed instructions, the examiner concludes that the ability of constituting "software" in accordance with the above combined systems if not inherently present would be further obvious to those of ordinary skill in the arts. Obviously, the controller doesn't operate/perform without a set of instructions.

With respect to claims 10-12, they are the method equivalents of the above apparatus claims and are met when the above combined systems operate.

7. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 10 above, and further in view of standard deviation practice, coarse-fine tracking abilities (Official Notice).

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As far as the examiner can ascertain from both the disclosure and claimed terminology, the "larger -smaller" relationship is standard criteria for narrowing a decision point, i.e., how much farther (larger), or closer (smaller) a present point is to a desired point.

Hence the examiner concludes that such a procedure (set of instructions) not only is well known (commonly used in coarse and fine tracking situations) but takes Official Notice thereto.

It would have been obvious to modify the base system of the references stated above in paragraph 6 with such standard ability, motivation is to ensure proper centering upon the decision point.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 10 above, and further in view of standard control discs concepts.

Claim 18 is written as a product, a medium, and upon this medium is a set of instruction to perform the appropriate control of a disc drive/sled. As noted above with respect to claim 5, the examiner concludes that a set of instructions are contained in the controller of the base reference, and in combination with the additional teachings from the secondary references/as further amplified by the submitted search report of 4/5/04, would be so stored in this device (controller is interpreted as a microprocessor).

The examiner takes official notice of control/set up/boot/recovery discs as being well known in the art. These discs have programs (a set of instructions) written thereon in order to perform a myriad of functions. Hence, the examiner concludes that it would have been obvious to one of ordinary skill in the art to further modify the above combined references with such a teaching and store the appropriate set of instructions upon a blank disc (such as a back up disc), and hence relieve the waste of memory in the hard drive. This also permits these instructions to be performed on a plurality of disc drives.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lim, which can be relied upon in place of the Song reference for teaching the overall system of controller, for a disc drive having tracking, sled ability, spindle motor control. Kuroiwa - see col. 8 lines 40 plus for

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his discussion focusing upon offset for tracking control. Kuroiwa et al can hence be relied upon in place of the JP 63-161538 document.

**Hard copies of the application files are now separated from this examining corps; hence the examiner can answer no questions that require a review of the file without sufficient lead-time.**

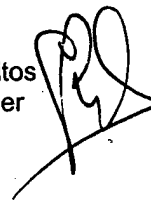
**Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.**

Any inquiry concerning the merits of this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653



AMP